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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,132	06/09/2005	Toshiyuki Kawaguchi	P/2850-109	2257
2352 7590 11/05/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER HARRIS, GARY D	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/538,132

**Applicant(s)**

KAWAGUCHI ET AL.

**Examiner**

Gary D. Harris

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

**DETAILED ACTION**

***Response to Amendment***

The office action acknowledges the receipt of Applicant's amendments to claims filed on 8/20/2007.

Claims 1-13 are pending and are examined in the instant application.

Claim 2 has been canceled by applicant.

Terminal disclaimer to overcome double patent rejection is acknowledged. Examiner withdraws double patent rejection.

Any rejection not set forth below has been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This action is made FINAL.

For convenience the first office action follows:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senda et al. US 5,990,417.

As to Claim 1, Senda et al. '417 discloses an electromagnetic noise absorbing material and relationship of relative magnetic permeability (Col. 1, Line 24-34) and further discloses an imaginary part of a relative magnetic permeability more than 102 in the band of a few hundred MHz (Col. 24, Line 62-65). Senda et al. '417 does not disclose the imaginary part H of a complex magnetic permeability at 8 GHz higher than the imaginary part L of a complex magnetic permeability at 5 GHz. However, these properties are inherent because the applicants and the inventors teach virtually identical structures with similar materials. The physical properties of similar materials will inherently be similar. The burden of proof is shifted to the applicant to show the prior art properties are different from those claimed. See *In re Fitzgerald*, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980).

As to Claim 2, Senda et al. '417 disclose a method in which an alloy of magnetic substance particles are mixed into a non-magnetic material (applicants binding agent) and would constitute a composite material (Col. 11, Line 53-56).

As to Claim 3, Senda et al. '417 discloses different manufacturing methods for depositing the magnetic material including physical vapor deposition (Col. 11, Line 51-52).

As to Claim 4, 5, 6 & 7, Senda et al. '417 discloses the use of phenol resins, epoxy resins, (applicants hardening resins) vinyl resins, acrylate resins, or synthetic rubber (applicants resin or rubber) (Col. 15, Line 24-25).

***Response to Arguments***

Applicant's arguments filed 8/20/2007 have been fully considered but they are not persuasive. Applicant argues basically that Senda et al. does not teach electronic noise suppression. However, to further clarify Senda et al. discloses throughout the specification the use of a material for electromagnetic noise suppression/filtering (see abstract and background) with a composite amorphous (complicated) structure (Col. 11, 12, Line 57-67, 1-5 respectively). Fig. 10 illustrates the magnetic particle being separated in the binder material. As Senda et al. has disclosed an amorphous material, it would not be crystalline. Additionally, at the interface between the binder and the magnetic material will have an area where atoms of the magnetic material are dispersed in the binding agents without crystallization (grain boundaries).

As to new Claim 13, the added phrase "a portion where the binding agent is observed" would be dependent on the magnification at which the material was being examined. Additionally, a complicated heterogeneous structure would be an amorphous structure and nanometer sized particles are disclosed by Senda et al. '417. Additionally, Senda et al. '417 teach variation in the distance between magnetic materials and the binding agent (figure 10 and Col. 22, Line 37-47).

Accordingly, this rejection is maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary D. Harris whose telephone number is 571-272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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CAROL CHANEY  
SUPERVISORY PATENT EXAMINER